WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

PLENTYOFFISH MEDIA, INC. v. Mr. Antony Tran/home, anh tran

Case No. D2009-0476

1. The Parties

The Complainant is PLENTYOFFISH MEDIA, INC. of Vancouver, Canada, represented by Christopher Hall & Associates, United States of America.

The Respondent is Mr. Antony Tran/home, anh tran, Westchester, of United States of America, represented by Law Offices of Deena B. Burgess, United States of America.

2. The Domain Name and Registrar

The disputed domain name <freedatingfish.com> is registered with eNom.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 13, 2009. On April 14, 2009, the Center transmitted by email to eNom a request for registrar verification in connection with the disputed domain name. On April 14, 2009, eNom transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 22, 2009 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on April 22, 2009. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 27, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response was May 17, 2009. The Response was filed with the Center on May 15, 2009.

The Center appointed James A. Barker as the sole panelist in this matter on May 25, 2009. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On June 1, 2009, the Complainant made a supplemental filing. On June 2, 2009, the Respondent requested permission to file a rebuttal. On June 3, 2009, the Panel notified the parties that it declined to consider the supplemental filing of the Complainant, and consequently declined the request of the Respondent to file a reply. It was noted to the parties that neither the Policy nor the Rules make provision for supplemental filings. The Panel reviewed the primary filings by both parties, and considered that there was sufficient information and argument to proceed to a decision.

4. Factual Background

The Complainant provides online dating services. Its business model is that of a free-dating web site, supported by advertising revenue.

The disputed domain name was registered on August 14, 2008.

At the date of this decision, the disputed domain name reverted to a 'portal' or 'pay-per-click' website displaying the title "Free Dating Fish With Plenty of Singles and Personals Online". The site displays various links to dating websites under subtitles such as "Plenty of Online Fish", "Singles Dating", "Sexy Local Single Girls", and "Free Online Chat". Below those links are a series of photographs of individuals under separate headings titled "Popular members" and "New members". The website also includes the following description:

"Welcome you to our free fishing dating service to fish singles online and personals, I like to thank you for visiting us today. Free dating fishing service offers members with a free service to find singles online. Many of fishes online are waiting just for you to contact them with. There are more and more of online fishes from usa, uk, or canada who are ready for their dates. We also have new fishing singles and personals who join daily. Please remember that this is not adult fishing dating personals service so do not post any sexual photos on our free fishing dating site."

5. Parties' Contentions

A. Complainant

The following is summarized from the Complaint.

The Complainant claims that the disputed domain name is confusingly similar to its registered marks for PLENTYOFFISH. The Complainant has registered rights in that mark in Canada, Australia, and the United States of America (on the principal register of the USPTO). Those marks were first filed on 2006. On the principal register of the USPTO, those marks are registered in relation to:

- "providing on-line forums for the transmission of messages among computer users concerning making acquaintances, friendship, dating, long-term relationships and marriage"; and

- "Computer services, namely, providing information regarding, and in the nature of, on-line dating and introduction services."

The descriptions of the services, in relation to which that mark is registered, are similar for the Complainant's Australian and Canadian-registered marks.

The Complainant believes that the disputed domain name should be understood to be a reference to its PLENTYOFFISH mark. The disputed domain name contains part of the Complainant's PLENTYOFFISH trademark (i.e., "FISH") and makes reference to "free dating" which is a well-known consumer impression of the Complainant's mark. The Complainant operates a 'free dating' online service, and the disputed domain name makes no sense other than as a reference to that service. The phrase "freedatingfish" is non-sequitur unless it refers to Complainant's site. "Fish" does not necessarily or easily follow from "freedating".

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has no relevant rights in a mark; is misleading Internet consumers by diverting them from the services of the Complainant; and has no connection with the Complainant.

For similar reasons, the Respondent registered and has used the disputed domain name in bad faith. The Complainant is the number one market share online dating service in both the United States of America and the United Kingdom of Great Britain and Northern Ireland with over an 18% market share in the United States of America. The Complainant's business model is that of a free-dating web site, supported by advertising revenue. The Complainant is very well known as the "free dating Web site Plenty of Fish". The Complainant's success as a free dating site has garnered considerable media attention.

There was an earlier complaint under the Policy regarding the domain name <plentyoffishdatingnow.com> (WIPO Case No. D2008-1218), which was withdrawn following a settlement with the Respondent resulting in the transfer of that domain name.

The Respondent uses the disputed domain name to host a web site which contains and displays Complainant's trademark. That website also makes infringing use of Complainant's trademarks. There are ten instances of the PLENTYOFFISH trademark or a variant thereof on the home page alone. The meta data on the Respondent's site contain the phrases "plenty of fishes" and "plenty of online fishes", which is an infringement of the Complainant's trademark rights.

B. Respondent

The Respondent made two substantive communications in connection with this case. The first was by email on April 27, 2009. The second was by way of formal response, submitted on May 15, 2009 by the Respondent's counsel. In the covering email to that formal

Response, the Respondent's counsel asked that the first communication from the Respondent be disregarded. For the reasons set out below under 'Discussion and Findings', the Panel did not disregard that first communication. Accordingly, what follows is a summary of both communications from the Respondent.

In his first communication on April 27, 2009, the Respondent, in summary, denied that the disputed domain name violated the Complainant's mark in any way. The Respondent admitted that the meta data for his site contains, as search terms, the Complainant's trademark PLENTYOFFISH, but says that his main reason for using those terms is for their generic meaning. The Respondent stated that the term "fish" has become well known to the general public as a term descriptive of single people actively seeking dating situations. He also stated that the Complainant's mark, and the disputed domain name, look and sound different.

In his formal response filed on May 15, 2009, the Respondent denies that the disputed domain name is confusingly similar to the Complainant's mark. The Respondent strongly disputes the Complainant's assertion that, by virtue of its trademark PLENTYOFFISH, it has the right to prevent any other person or entity from using the word "fish" as it pertains to dating. The Complainant's mark is not particularly strong. As a common idiom, the phrase "plenty of fish" refers to the fact that "there are lots of possible girlfriends or boyfriends". As the word "fish" as it refers to dating has become generic, the Complainant cannot possibly have an exclusive right to any use of the word "fish" as it relates to dating. The Respondent refers to the marks of third parties which contain the word "fish" registered in relation to dating services.

The Respondent argues that he has legitimate interests and rights in the domain name. This is because of his use of the disputed domain name to offer free online dating services. Separately, the Respondent also argues that he is commonly known by the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy. The Respondent currently has an estimated 30,000 visitors to his web site per month. That web site has thousands of members. As such, the name has acquired a distinctiveness and a brand recognition of the name Free Dating Fish.

The Respondent also denies that he has acted in bad faith, within the meaning of paragraph 4(b) of the Policy as argued by the Complainant. The Respondent is certainly free to register a domain name using the word "fish" for his free internet dating site. Having a similar business model to the Complainant's is not enough, in and of itself, to evidence bad faith. The registration and use of the disputed domain name was not done in bad faith. No person who goes to the Respondent's website mistakenly thinks that they are at the Complainant's website. The Complainant offers no evidence of actual confusion by customers because there is none.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must prove that:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name was registered and is being used in bad faith.

These issues are discussed below, immediately after discussion of a procedural issue raised by the Respondent's counsel's request to disregard the Respondent's communication filed on April 27, 2009.

A. Request to disregard Respondent's communication

In the covering email of May 15, 2009 to its formal Response, the Respondent's counsel requested that the Respondent's initial Response, filed on April 27, 2009, be disregarded. The Panel presumed that this request was made because the Respondent's counsel considered that that initial Response did not advance the Respondent's case, or introduced evidence or argument that was not in some respect helpful to the Respondent's case.

The Panel has however has considered that initial Response, together with the formal Response. Ultimately, the task of the Panel is to consider all the presented evidence, to make a decision on the merits of the case in accordance with the Policy and Rules. It is difficult to take this approach and disregard a filing deliberately submitted by the Respondent.

The Panel does not consider that such an approach denies the Respondent a fair opportunity to present his case, in accordance with paragraph 10(b) of the Rules. Fairness does not require a Panel to artificially ignore material put into evidence by either party, merely because of a later request by that party. Rather, fairness would usually require the Panel to consider all the evidence presented by both parties in accordance with the Policy and Rules.

B. Identical or Confusingly Similar

Paragraph 4(a) of the Policy requires the Complainant to prove two things to succeed.

Firstly, the Complainant must show that it has rights in a mark. There is no dispute that the Complainant has such rights in its registered PLENTYOFFISH mark.

Secondly, the Complainant must show that the disputed domain name is either identical or confusingly similar to its mark. The disputed domain name is plainly not identical to the Complainant's mark. The Complainant argues instead that it is confusingly similar. The Complainant makes this argument on the basis of a collective set of factors. These include claims that the disputed domain name should be understood to be a reference to its mark; that the reference to 'free dating' is a well known consumer impression associated with its mark; and that the domain name makes no sense other than as a reference to its mark. In response, the Respondent claims that the disputed domain name and the Complainant's mark look and sound different; that the Complainant's mark is not particularly strong; and that the word "fish" has become a generic idiom relating to dating in which the Complainant cannot have exclusive rights.

As noted by previous Panels, there is a spectrum of views about the scope of the test for determining confusing similarity. "Some [Panels] have limited the test to determining the degree of resemblance of the domain name and mark at issue as to 'sight, sound, and meaning.' Others have considered the degree of resemblance along with factors such as the distinctiveness of the mark, how well-known the mark is, how long the mark has been used, and the nature of the goods and services with which the mark is used." *National Spiritual Assembly of the Bahá'ís of the United States v. Second International Bahá'í Council*, WIPO Case No. D2005-0214.

It might be thought that these differing approaches represent either a narrow approach (looking only at, e.g., 'sight, sound and meaning') or a broad approach (looking at other factors, such as the distinctiveness of the mark, how well-known it is, etc). This Panel considers that those approaches, however, will often not be that far apart. Even on a 'narrow' approach, whether a disputed domain name is similar to a mark in sight, sound and meaning must involve the Panel making a judgment. Depending on the facts of the case, such a judgment will often be influenced by factors including the distinctiveness of the mark, how well known it is, etc. It is also important to note that the test involves not only a question of whether the mark and domain name are similar: That similarity must also be confusing. Again, whether a particular similarity is confusing will often involve a judgment about whether all the facts would lead relevant Internet users to be confused about the association between a domain name and a complainant's mark.

As such, this Panel has taken into account all the factors which it judges have a bearing on the resemblance between the disputed domain name and the Complainant's mark. This includes factors such as the degree of visual and aural similarity, similarity of meaning, the distinctiveness and reputation of the Complainant's mark.

Having regard to those factors, the Panel finds that the disputed domain name is not confusingly similar to the Complainant's mark. On a side-by-side visual comparison there is little similarity. The only similarity is the use of the generic word "fish". But the use of that word is combined, in each case, with entirely different words. In the Complainant's mark it is preceded by the words "plenty of". In the disputed domain name it is preceded by the words "free dating". The use of those different words also mean that there is little aural similarity.

It is true that both the disputed domain name and the Complainant's mark relate to a similar idea: the association between the word "fish" and dating. But, as the Respondent argues, that idea is not exclusively or distinctively associated with the Complainant. The Respondent provides evidence of marks of third parties registered in relation to dating services. As this Panel has previous noted, whether the idea of a mark is suggested by a disputed domain name is related to the question of whether a distinctive element of the Complainant's mark is incorporated in the domain name, on an overall comparison. (See *Telstra Corporation Limited v. Mandino Pty Ltd*, WIPO Case No. DAU2006-0006.) There is little evidence presented in this case that suggests such an incorporation. The disputed domain name and the Complainant's mark share only the generic word "fish". The Complainant argues that 'free dating' is a "well known consumer impression" of its services; and that it "is very well known as the 'free dating Web site Plenty of Fish'." The Complainant provides little evidence to support these statements. Evidence it presents of its market share and references to it in the media indicates that the Complainant's services are well-used. But that is not the same thing as showing that the Complainant is distinctively associated with the terms "free dating". It is similarly not the same thing as showing such an association with its trademark *per se*.

For these reasons, the Panel finds that the disputed domain name is not confusingly similar to the Complainant's mark.

C. Rights or Legitimate Interests

For the reasons set out above, it is not necessary for the Panel to make a finding on this ground.

D. Registered and Used in Bad Faith

Again, for the reasons set out above, it is not necessary for the Panel to make a finding on this ground.

In doing so, the Panel notes that the Respondent was clearly aware of the Complainant's mark, as evidenced by, e.g., his previously being the subject of a settlement with the Complainant regarding the registration of another domain name. (In this respect, both parties refer to WIPO Case No. D2008-1218, regarding the domain name <plentyoffishdatingnow.com>. The Complainant noted that that case was terminated in 2008 following a settlement between the parties.) The Respondent's web site also included the phrase "Plenty of fish" and "Plenty of fish free" *per se* in its meta data. Having regard to the Respondent's direct awareness of the Complainant, the Panel is not entirely convinced that the Respondent did so soley because of the generic association of those terms. Regardless, the Complainant must succeed on all the grounds set out under paragraph 4(a) of the Policy. As the Complaint cannot succeed on the first ground, for the reasons set out above, it was not necessary for the Panel to consider this third ground further.

7. Decision

For all the foregoing reasons, the Complaint is denied.

James A. Barker
Sole Panelist

Dated: June 12, 2009